



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : WAYNE ODOM ET AL)
Serial No. : 09/977,138)
Filed : October 12, 2002)
For : Electronic Card Game)
Examiner : Christina Marks)

Group 3713

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March 15, 2004
(Date)
Kellie Carr

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APPELLANT'S BRIEF (REVISED)

Appellant, pursuant to 37 C.F.R. § 1.192 submits his revised brief in support of his appeal of the final rejection of all Claims 1 - 48 of the above-identified application, a copy of which are provided in the Appendix.

1. Real Party in Interest

The present application has been assigned, in its entirety, to Karaway Gaming, a Nevada corporation having an address of 8797 East Broadway Blvd. Tucson, AZ 85710 ("Assignee"). Assignee has entered onto an exclusive license for invention with WMS Gaming Inc., a Delaware corporation having offices at 800 South Northpoint Blvd, Waukegan, Illinois 60085

2. Related Interferences and Appeals

None.

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3. Status of the Claims

All pending Claims 2 - 48 pending¹ as of the final Office Action dated October 6, 2003 stand finally rejected under 35 U.S.C. § and 103. The Examiner has also provisionally rejected the claims for obviousness double patenting. The final

5 rejection of all Claims 2 - 48 is the subject matter of this appeal.

4. Status of Amendments

None

5. Summary of the Invention

The present invention is directed to a method and electronic device for playing a
10 card game, such as a Video Poker game, which includes providing a data processor
including a first data structure storing data representing at least one deck of N playing
cards according to the rules of the game. Specification page 4, lines 21-24. In the first
data structure the card data is configured a random, serial order representing a deck of
shuffled cards. Specification page 5, lines 1 - 2. Other arrangements of data may be
15 used to simulate the serial and random arrangement of a shuffled deck of cards.
Specification page 9, lines 4 - 6. As the player plays a series of hands of play, the data
of data structure representing the prior selected and displayed cards is depleted, e.g.
removed from play. Specification page 10, lines 1 - 4. The processor depletes the
deck data and displays the remaining constituency of the card data so the player knows
20 which cards remain available for selection and display. Specification page 10, lines 28 -

¹The Final Office Action indicates that claim 1 has been finally rejected; however, claim 1 was cancelled in the prior Office Action leaving claims 2 - 48 as the pending and finally rejected claims.

30.

Where depletion of the deck data by selection and display of card data makes certain winning outcomes impossible, e.g. a Royal Flush outcome is no longer available, the processor would remove that outcome from a displayed table of winning outcomes. Specification page 12, lines 19 - 23.

The player may command reconstitution of the deck data or it may be re-constituted by based upon the card data which has been displayed. Specification page 12, lines 24 - 25. Where depletion of the deck data reaches a predetermined amount, the processor may command reconstitution of the deck data. Specification page 13, lines 1 - 5.

The feature of displaying the remaining constituency of the deck through the play of a series of hands can also be incorporated into video versions of Blackjack, Baccarat and other games. Specification page 5.

6. Issues Presented on Appeal

1. Whether the rejection of claims 2 - 4, 6 - 14, 16 - 20, 22 - 30, 32 - 38 and 40 - 48 as being obvious under 35 USC § 103 over Fuchs (U.S. Patent 5,630,753) in view of Kinoshita et al (U.S. Patent 5,967,894) is proper;

2. Whether the rejection of claims 5, 15, 21, 31 and 39 as being obvious under 35 USC § 103 over Fuchs (U.S. Patent 5,630,753) in view of Kinoshita et al (U.S. Patent 5,967,894) and further in view of Richardson et al (U.S. Patent 5,042,809) is proper.

7. Grouping of Claims

Applicant submits that the claims be grouped as follows:

Group 1

Claims 2 - 4, 6 - 14, 16 - 20, 22 - 30, 32 - 38 and 40 - 48. Applicant submits that

5 claims 37, 38, 11 and 42 are representative and the claims of the group stand or fall upon the resolution concerning the representative claims.

Group 2

Claims 5, 15, 21, 31 and 39. Applicant submits that claim 5 is representative and the claims of the group stand or fall upon the resolution concerning the

10 representative claim.

8. Argument

As to all Groups

The Examiner has provisionally rejected all pending claims based upon double patenting. It is submitted that the double patenting issue is not ripe for this appeal

15 inasmuch as it is unknown what patentable subject matter is for this application and co-pending, commonly owned, application serial number 10/121,884. Until patentable subject matter has been indicated, applicant cannot address the issues of double patenting.

Group 1 Claims

20 1. Claim 37

Claim 37 has been rejected as being obvious over Fuchs (U.S. Patent No. 5,630,753) (hereinafter "Fuchs") in view of Kinoshita et al (U.S. Patent 5,967,894)(hereinafter "Kinoshita").

Claim 37 recites a method which includes selecting and displaying card data from a data structure to define an outcome for a hand of play. As described in the specification the game may be Blackjack, Baccarat, Poker or the like. If the outcome is a winning outcome according to the predetermined rules of the game, the player gets an award. Claim 37 also recites depleting the card data available for selection and display for subsequent selection and display, of the card data which has previously been selected and displayed. The example set forth in the specification for the present application is instructive of this feature.

"Thus, if the deck data was a full deck of fifty-two cards of a standard deck of playing cards, the deck by the retrieval and display of five playing cards has been (1) depleted of five cards and (2) specifically depleted of cards 10♣, 3♣, A♣, 4♠, 10♠. The processor re-tabulates the table 34 to account for the depletion of the deck. That is, before and after the display of the cards of the initial holding the table 34 would be altered as suggested below and as reflected in FIG. 1:

Table Before Initial Deal	Table After Initial Deal
A's 4	A's 3
K's 4	K's 4
Q's 4	Q's 4
J's 4	J's 4
10's 4	10's 2
9's 4	9's 4
8's 4	8's 4
7's 4	7's 4
6's 4	6's 4
5's 4	5's 4
4's 4	4's 3
3's 4	3's 3
<u>2's 4</u>	<u>2's 4</u>
52	47

(Bold cards reflect deck constituency change)"

Specification page 10, lines 6 - 26.

Claim 37 also recites displaying information to the player of any winning outcome eliminated by the depletion of the available data. For example, if deck depletion has
5 eliminated the possibility of the player obtaining a Royal Flush (Suited 10 - Ace) by, for example, depletion of the 4 Kings from the deck data, the display would indicate that the player can no longer obtain a Royal Flush.

Claim 37 also recites the play of subsequent hands by repeating the steps of the player making a wager, the random selection and display of cards, judging whether the
10 outcome is a winning or losing outcome and depleting the card data. As set forth in the specification, for a subsequent hand the player would make another wager and play the hand using the depleted deck data. That is, in the example above, the player may play the next hand using a deck depleted (by the play of the prior hand) from 52 cards to 44 cards. Specification page 10 line 6 through page 13, line 18, FIGS 1 and 2. Thus at
15 the start of a subsequent (and new hand), according to the present invention, the player plays with a deck which has been depleted of cards as a result of the play (now a 44 card deck) of the prior hand(s).

The Examiner relies upon Fuchs as disclosing the features of claim 37.

Applicant asserts that (1) Fuchs does not disclose or suggest the features of claim 37,
20 (2) that the application of Fuchs is as a result of hindsight, (3) that Fuchs, in fact, teaches away from the claimed invention and (3) that the Examiner has not made the requisite showing of evidence for obviousness.

The Examiner bears the initial burden of factually supporting a prima facie case of obviousness. MPEP § 2142. To support the conclusion that the claimed invention is

directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of teachings of the references. MPEP §2142.

5 To establish a *prima facie* case of obviousness, there must be some suggestion or motivation (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) to modify the reference teachings. The prior art reference (or references when combined) must teach or suggest **all** the claimed limitations. MPEP §2143. Obviousness can only be established by combining or
10 modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to those skilled in the art. *In re Fine* 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.01. A statement that modifications of the prior art, to meet the claimed invention, would have been well within the ordinary
15 skill in the art at the time the claimed invention was made, is not sufficient to establish *prima facie* obviousness without some objective reason to combine the teachings of the prior art. MPEP §2143.01. Further, if the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious.
20 MPEP §2143.01. Further there must be some showing of a motivation or teaching of the desirability of making the specific combination that forms the claimed invention. *In re Oetiker* 25 USPQ2d 1443 (Fed. Cir. 1992). This requirement cannot be satisfied by

broad conclusory assertions since the same do not qualify as evidence. *In re Dembicziak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The Patent Office is not permitted to make assumptions as to basic knowledge simple alleged to be possessed by all those of ordinary skill in the art and then to rely on this assumption as a substitute for the required production of evidence showing motivation. *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001). The mere allegation of the existence of common knowledge in the art does not make it so and thus evidence of such knowledge is required to be shown. *In re Lee* 61 USPQ2d 1430 (Fed. Cir. 2002).

Fuchs discloses a game where the player is presented with a first set of randomly selected symbols from which the player can hold symbols over to the next game. The game processor displays, based upon which of the symbols the player holds, the possible winning outcomes the player may obtain and the probability for obtaining each. Fuchs, Col. 6, lines 10 - 36.

The Examiner has interpreted Fuchs to disclose or suggest that "Once a symbol has been presented, the card data is depleted for further selection and display (Column 9, lines 55 - 67). Card data about previous hands is also shown (Column 9, lines 55 - 67). The player can the play a subsequent amount of hands (Column 9, lines 60 - 67)."

Applicant traverses the Examiner's interpretation of Fuchs. Fuchs does show intra hand depletion, however it does not disclose (1) depletion which carries over to subsequent hands of play as set forth in claim 37 nor does it show (2) display of the elimination of outcomes which may occur as a result of depletion.

Fuchs does not teach that depletion carries over to subsequent hands of play, as

is recited in claim 37. Fuchs teaches that depletion only occurs between the initial deal and the deal of replacements for any non-held symbols². It is respectfully submitted that Fuchs does not teach depletion over a series of hands, e.g. through a series of outcomes. It is true that Fuchs does state:

5 "... the game symbols displayed or those selected by the player, especially the symbols selected for a next game, or on which a win is based, will be eliminated from the large number of predetermined game symbols of from the respective still available set of game symbols and will no longer be offered in any subsequent games." Fuchs,

² "... **in the next game or section of the game** the player the player is offered by the computer unit, according to randomizing criteria or arbitrary predetermined criteria, game symbols taken from the large number of predetermined or **still available game symbols to replace the non-selected or non-stored game symbols**." Col. 1, lines 33 - 37

"... and the said combinations of game symbols are given or are perhaps attainable in the next game or next section of the game, using the game symbols offered or available, or using the **game symbols ... stored by the player ... for the next game or the next section of the game**". Col. 1, lines 49 - 55

"The specific aim of the invention is to indicate to the player what are the best chances which he has of winning in a subsequent game, given the symbols or combinations of symbols which are displayed or which he has held." Col. 2, lines 39 - 43).

"... the **two aces are stored for the next game** or play and the computer unit 5 offers the player new game symbols only at positions 2, 3 and 5 in the next game, and these symbols may also include aces, thus to a greater or lesser extent improving the offered chances of winning." Col. 6, lines 43 - 47

"Normally the game proceeds by requiring the player to bet a certain amount of money for the first game and, if necessary, to bet a further certain amount of money for the subsequent game or play, although **in the second game or the subsequent section of the game, certain game symbols may have been predetermined by the first game**." Col. 7, lines 45 - 51

Col. 3, lines 54 - 60.

Applicant submits that, given the other description set forth in Fuchs, that those skilled in the art would interpret Fuchs to provide (1) a game having an initial deal, (2) with the next game being played by holding/discarding the symbols of the initial deal, i.e., first game, to produce an outcome (game 1 outcome) and (3) a next game where the player can hold/discard symbols from the previous outcome (game 1 outcome) to, in essence "build" one or a series of outcomes. That is, Fuchs does not carry over deck depletion to the next hand, as set forth in claim 37, but merely provides for deck depletion during the play of one hand, which may encompass a series of outcomes.

Fuchs does not disclose or carry over deck depletion to the next hand. Fuchs states:

"Normally the game proceeds by requiring the player to bet a certain amount of money for the next game and, if necessary, to bet a further certain amount of money for the subsequent game or play, although in the second game or the subsequent section of the game, certain game symbols may have been determined by the first game."

Fuchs, Col. 7, lines 46 - 51.

Given the other passages of Fuchs referred to above, it is submitted that those skilled in the art would interpret Fuchs to play a hand of play which encompasses a series of games where each subsequent game includes player held symbols from the previous game.

It is therefore respectfully submitted that Fuchs does not teach the carryover of depletion to subsequent hands as set forth in claim 37. Applicant also respectfully submits that the interpretation of Fuchs put forth by the Examiner is based upon impermissible hindsight of interpreting Fuchs to disclose or suggest depletion carryover

when a fair reading of Fuchs does not teach carryover.

Applicant further submits that Fuchs does not disclose or suggest the display of information to the player of elimination of any outcome as a result of depletion as set forth in claim 37. Fuchs discloses the display of possible outcomes based upon the
5 player's hold decisions. The Examiner has taken the position that "One of ordinary skill in the art could thus say that the information is displayed regarding winning outcomes that have been eliminated." Final Office Action, page 8. However, the Patent Office is not permitted to make assumptions as to basic knowledge simply alleged to be possessed by all those of ordinary skill in the art and then to rely on this assumption as
10 a substitute for the required production of evidence showing motivation. *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001).

Fuchs, in fact, teaches away from this feature by providing:

" In order to ensure that an adequate number of game symbols is available at all times, provision can be made that after a certain number of games or after a
15 certain number of game symbols have appeared, **the number of available game symbols can be added to in a random fashion or predetermined fashion...**" Col. 10, lines 1 - 6.

Thus, Fuchs '753 teaches that there must always be an adequate amount of game symbols to provide a chance for winning each winning outcome. Applicant, on the other
20 hand, lets depletion occur even to the point where certain outcomes become eliminated.

Further, displaying the probabilities of obtaining a winning outcome, as disclosed

in Fuchs, is vastly different from displaying the outcomes which have been eliminated as a result of depletion. Even if Fuchs permitted depletion to eliminate certain outcomes (which it does not), the player would have to have a certain starting set of symbols AND make certain hold decisions to generate a display that the probability of obtaining an outcome is "zero". Any eliminated outcomes would only become known based upon (1) the cards dealt to the player and (2) the player's hold decisions. That is, if the player were dealt a hand of 7♥ 4♣ 9♠ 4♦ 2♦ in Fuchs he would have no way of knowing if the Royal Flush has been eliminated since none of the hold decisions would prompt Fuchs to display this information in that there are no cards in the initial holding which could be included in a Royal Flush. Further, if the player decides not to hold any cards of the initial holding, Fuchs again would not display which outcomes have been eliminated. For example, with the hand of 7♥ 4♣ 9♠ 4♦ 2♦ and the player decides to hold none of the cards, NO information would be imparted to the player whether any fours of a kind, straight flushes, straights, full houses or the like have been eliminated due to inventory depletion. In Fuchs, the player must make a hold decision before any information is imparted to the player. Where, as in the present invention according to certain claims, the player has the option of commanding reshuffling, information as to which outcomes cannot be obtained due to depletion (regardless of any hold decisions the player may make) can be useful to the player in their strategy as to whether or not command re-shuffling. The invention of claim 37 does not require any initial holding of cards or any player action (holding cards) to display that, for example, any Royal Flush has been eliminated as a result of depletion.

It is respectfully submitted that, based upon the foregoing, any interpretation that

Fuchs displays information as to which outcomes have been eliminated is based upon impermissible hindsight.

The Examiner has also cited Kinoshita for showing the feature of the displaying of information for any outcomes which have been eliminated by depletion. This

5 reference suffers from the same deficiencies as Fuchs. Kinoshita does not disclose or suggest deck depletion and, as a result, no outcome of this reference is eliminated as a result of depletion. Kinoshita does show which outcomes of a pay table are unavailable as a result of which cards the player decides to hold (like Fuchs). The Examiner has referenced FIGS. 8(a) and (b) in support for her position. However, these drawings and
10 the description of Kinoshita do not support a conclusion that (1) outcomes are eliminated by depletion and (2) that information of eliminated outcomes is imparted to the player. In Kinoshita FIG. 8(a) all pay table combinations are available (none have been eliminated). Thus if the player choose not to hold any of the cards of the initial holding and replace all the cards, a Royal Flush is still available. According to the
15 present invention, if the Royal Flush (or any other possible winning outcome) has been eliminated through depletion (for example all of the Kings have been depleted by prior hands), that information would be displayed to the player so that he/she would know that no matter what the hold decision may be, depletion has eliminated any possibility that than outcome can be obtained.

20 As a further point, the Examiner has taken the position that it would have been obvious to one of ordinary skill in the art to incorporate the display method of Kinoshita into the system of Fuchs. (Final Office Action, page 9). Applicant respectfully disagrees and further submits that there is no objective teaching in the cited art to support this

conclusion. Neither reference addresses the feature of depletion which results in the elimination of winning outcomes and the display of information regarding eliminated outcomes. Kinoshita does not disclose depletion or elimination of outcomes as a result of depletion.

5 The Examiner also states that one would be motivated to to implement the teachings of Kinoshita into the Fuchs system in order to provide the player with a more informative display and help a player who is not familiar with the card game learn the game by seeing not only outcomes that are possible, but those which have been eliminated. (Final Office Action, page 9). The Examiner has not put forth any
10 subjective teaching from the prior art to support this assertion, particularly where neither reference discloses this feature. Neither reference shows elimination of possible outcomes caused by deck depletion. These references show elimination of possible outcomes caused by player choice, which is well known in the art. It is axiomatic that if a player holds certain cards, certain outcomes become unavailable on the draw. This is
15 not due to deck depletion, but simply the play of the game which uses only five cards. If a player holds a pair of 4s, he/she cannot get a Straight Flush, Royal Flush, four Aces, Straight or Flush simply because the holding of the pair of 4s makes these outcomes unavailable. They have not been eliminated by depletion. The outcomes have been eliminated by player choice

20 The Examiner has also taken the position that one of ordinary skill in the art certainly understands that random processes could eliminate winning outcomes before the refresh event. Final Office Action, page 14. Here, again, the Examiner has not pointed to any cited art for this proposition contrary to the requirements of *In re Oetiker*

supra, *In re Dembicziak, supra*, *In re Zurko, supra* and *In re Lee, supra*. It is also submitted that the position adopted by the Examiner is based upon impermissible hindsight reconstruction inasmuch as Fuchs teaches adding symbols to avoid the elimination of outcomes. It is also respectfully submitted that the application of

5 Kinoshita, which makes no mention of deck depletion and the resultant elimination of outcomes, underscores applicant's position that the Examiner has used hindsight.

Therefore, neither Fuchs or Kinoshita show the features of claim 37 including the features of deck depletion, elimination of outcomes as a result of deck depletion and the display of any eliminated winning outcomes. It is respectfully submitted that the

10 Examiner's rejection is based upon impermissible hindsight and attempting to "bootstrap" the failed teachings of the cited art into claim 37 to render it obvious.

Reversal of the rejection of claim 37 is solicited.

2. Claim 38

Claim 38 depends from claim 37 discussed above and includes the feature of, at

15 a predetermined depletion of the card data, reconfiguring the deck data available to data representing N cards. This feature reconfigures the deck data back to its full complement, e.g. data representing 52 cards, when depletion reaches a certain amount such as depletion of the 30 cards from the deck of 52 cards.

Claim 38 has been rejected as being obvious over Fuchs in view of Kinoshita.

20 Applicant submits that the features of deck depletion and the display of information of eliminated outcomes of base claim 37 has been addressed above.

As for the feature of reconstitution, the Examiner has taken the position that Fuchs discloses this feature, citing Col. 9, lines 47 - 51. (Final Office Action, page 8.).

The referenced passage reads:

“At the player’s request or because of a repeatedly appearing display, the player
- as shown in Fig. 5, left, is presented, in winning chances display panel 7’, with an
initial display of the game symbols available at the start of the game.” Fuchs, Col. 9,
5 lines 47 - 51. The Examiner has interpreted this passage as disclosing that it is
possible to reset the entire number of game symbols for further selection and display
and has held that:

“Though Fuchs discloses that a certain number of hands are used as the
determining factor, it would be obvious to one of ordinary skill in the art to use a certain
10 number of symbols as the limiting factor. One would be motivated to do this because
the symbols represent the actual inventory, thus providing a better indication of when
the count of cards may be getting low. Inherently a counter would be used to determine
the number of symbols in order to issue a signal to reconstitute at a certain number.”

(Final Office Action, page 9.) Applicant submits that the Examiner has not put forth

15 any reference or evidence to support her conclusions. There must be some showing of
a motivation or teaching of the desirability of making the specific combination that forms
the claimed invention. *In re Oetiker* 25 USPQ2d 1443 (Fed. Cir. 1992). This
requirement cannot be satisfied by broad conclusory assertions since the same do not
qualify as evidence. *In re Dembicziak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The Patent
20 Office is not permitted to make assumptions as to basic knowledge simply alleged to be
possessed by all those of ordinary skill in the art and then to rely on this assumption as
a substitute for the required production of evidence showing motivation. *In re Zurko*, 59
USPQ2d 1693 (Fed. Cir. 2001). The mere allegation of the existence of common

knowledge in the art does not make it so and thus evidence of such knowledge is required to be shown. *In re Lee* 61 USPQ2d 1430 (Fed. Cir. 2002). The Examiner acknowledges that Fuchs does not teach symbol depletion driven reconstitution of the deck data. No reference has been cited to show motivation to alter the plain teaching of Fuchs. Still further, it may be said that Fuchs does not state that the symbol data is reconstituted, but only that a particular display is provided because of a repeated display. It is submitted that the Examiner's interpretation of the above passage of Fuchs as disclosing reconstitution based upon depletion to be based on impermissible hindsight which has been used to misinterpret the teachings of Fuchs and provide the necessary motivation.

The Examiner has also taken the position that Fuchs discloses it would be obvious to one of ordinary skill in the art, especially when playing poker, that since the provision for reshuffling has been met, to reconstitute the deck to a form representing the entire deck, as is notoriously known in the art when a card or poker game reaches a point of reshuffle. Here again, the Examiner has not put forth any subjective teaching in the art to support that any prior electronic poker game provides for deck depletion or depletion triggered reconstitution, as is required³.

Reversal of the rejection of the claims of this Group is respectfully requested.

3. Claim 11

Claim 11 recites the feature of means for randomly arranging said playing card

³ *In re Dembicziak*, 50 USPQ2d 1614 (Fed. Cir. 1999); *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001). The mere allegation of the existence of common knowledge in the art does not make it so and thus evidence of such knowledge is required to be shown. *In re Lee* 61 USPQ2d 1430 (Fed. Cir. 2002)

data into random serial order. As described in the specification, this feature randomizes the card data, e.g. cards, and arranges the data into a serial structure $N_1 - N_{52}$, for example, representing a randomized deck of fifty-two cards.

The Examiner has rejected claim 11 as being obvious over Fuchs in view of Kinoshita. The Examiner's position is that it would be obvious for one of ordinary skill in the art that the symbols could be accessed randomly from the list data structure and then accessed serially. Final Office Action, page 7. The Examiner has not cited any reference or evidence in support of this position. Neither Fuchs or Kinoshita disclose or suggest this feature.

Reversal of the rejection of this claim is requested.

4. Claim 42

Claim 42 has been rejected as being obvious over Fuchs in view of Kinoshita.

As discussed above, Kinoshita does not disclose or suggest deck depletion nor does it disclose or suggest the displaying of a tally of the deck data as depleted by the

selection and display of cards for preceding hands of play, including the display of any card values of any card values and suits which have been completely depleted. Fuchs also does not disclose or suggest the feature of displaying the tally including where card values or suits have been eliminated. Fuchs, as discussed above with reference to the Group 1 claims, teaches away from this feature. Fuchs states " In order to ensure that

an adequate number of game symbols is available at all times, provision can be made that after a certain number of games or after a certain number of game symbols have appeared, **the number of available game symbols can be added to in a**

random fashion or predetermined fashion...” Col 10, lines 1 - 6.

Thus, Fuchs teaches that there must always be an adequate amount of game symbols to provide a chance for winning each winning outcome. This teaching is contrary to a method where depletion can completely eliminate from the data card values or suits available for the next hand of play. Applicant lets depletion occur even to the point where certain symbol data has become eliminated.

Applicant requests reversal of the rejection of claim 42.

Group 2

1. Claim 5

This group of claims is directed to the feature of permitting the player to reconstitute the deck data. Claim 5 recites the method of claim 37 (Group 1 claim) comprising the player reconstituting the deck data.

The Examiner has rejected claim 5 as being obvious in view of Fuchs in view of Kinoshita and Richardson (U.S. Patent 5,042,909) (hereinafter “Richardson”). The Examiner has noted that Fuchs does not disclose allowing the player to call for reconstitution. Final Office Action, page 13. The Examiner has cited Richardson for the proposition that it is advantageous for the player to call for a new deal after all of the winning chances have been redeemed. Final Office Action, page 13.

In Richardson the player is selecting “tickets” from a predetermined ticket set.

As is known in the pull tab art, the ticket set (referred to as the “deal”) includes a predetermined number of tickets, e.g. 500 tickets (like a reel or book of scratch-off lottery tickets which are purchased by players in states providing for such lotteries) , and each ticket has printed thereon a winning or losing outcome, like a scratch-off

lottery ticket. For example a ticket may have printed thereon ☆☆☆ which is predetermined as a winning combination. The only random feature of a pull-tab game is which ticket is purchased from the set is selected (again like a lottery game). The distribution of winning versus losing outcomes and the prizes for winning outcomes is predetermined such that the sale of the ticket set for the play of the game can produce a profit. Thus, for example, if there are 500 tickets in the pull -tab ticket set, and each ticket sells for \$1, the sale of all tickets would bring in \$500. To turn a profit, the sum of all winning outcome awards would be less than \$500, e.g. \$450, so the operator, who purchased the “deal” (set of lottery tickets) can turn a profit. Thus, the only thing in Richardson that is random is the selection of a ticket (bearing a predetermined winning or losing outcome and, if it is a winning outcome, the award) from the ticket set which is akin to pulling a ticket from bowl containing all tickets. The outcome for that ticket is not random vis-a-vis the symbols for that ticket are predetermined and were long ago printed on the ticket and were chosen to conform to the profit criteria described above. Thus the symbols for the outcome are NOT randomly selected from a data structure when the player makes the wager and prompts play, the combination of which defines the previously undetermined outcome. Nor is there any requirement to assess the cards selected to determine whether the randomly selected cards are a winning or losing outcome since, in Richardson, the ticket when printed (well before the purchase by the customer) was already determined to be a winner or a loser.

“Deal” as used in Richardson has a different meaning that randomly selecting cards from a data structure of cards to define an outcome as recited in base Claim 37. Richardson states:

"In addition, each game has as many as 50 deals [lottery ticket sets] stored in memory on a computer chip module. ... After all of the higher level winners have been redeemed, the deal [lottery ticket set] is retired from play and the next deal [lottery ticket set] for that game (if any remain) is put in place." Col/ 4, lines 39 - 55.

5 "... he has the opportunity to select a new Deal Screen 28 ... with a new offering of nine chances" Col. 11, lines 48 49. [This is the selection of nine tickets from a game ticket set]

"This is the procedure of playing a deal only so long as at least one of the higher level winners ... remains available to be won within the deal [lottery ticket set]."

10 Col. 16, lines 31 - 34.

Thus "deal", in the context of Richardson means either the display of chances (e.g. nine tickets selected from a ticket set) or the entire inventory of tickets for a particular pull - tab game. When Richardson refers to allowing a "new deal" after all of the tickets have been redeemed, he is referring to a new inventory set of pull tab tickets for a different game. During the play of a pull tab game (sale and revelation of the tickets of the inventory), the player does not have the opportunity to reconstitute the ticket set. He must, if he wants to go to a game with more tickets left in the inventory, go to another ticket set, e.g. another game or "deal". It should be understood that in pull tab games the number of tickets in the inventory is strictly controlled by gaming regulations. Thus in the pull tab art, allowing a player to add more tickets (reconstitute) to a ticket set (i.e. "Deal") would not be permitted since the same would affect the overall performance of the game. For example, if the pull tab game had only sold 20% of the tickets but most of the prizes had been won, reconstituting the inventory of tickets

would render the previous ticket set unprofitable (if more winners were added) or unfavorable to the player (if more losers were added).

It therefore is submitted that Richardson teaches away from the present invention by (1) being directed to a pull tab game as opposed to a game where
5 individual cards (symbols) are selected and combined to define outcomes (2) not permitting reconstitution of the original inventory of card data (the player cannot command adding new tickets into the ticket set bowl) and further (3) for not displaying which outcomes have been eliminated by depletion of the data by selection and display of symbols. Richardson shows winners which remain in the ticket inventory, since the
10 number, composition and amount of winners is predetermined. For example, in Richardson, is a \$100 winning ticket remained in the "deal" he would display that this ticket remains and has not yet been purchased. In Applicant's game, the number of winners or losers is not predetermined, but is randomly decided by selection and display of the individual card data. For example, and to illustrate the contrast between
15 applicant's invention and that of Richardson, from a deck data inventory of 52 cards and selecting 5 cards, the player may not have a single winner before the deck is depleted. The cards selected may not form a winning combination. However, in Richardson, the number and character of winning and losing tickets is pre-ordained just like a scratch-off lottery ticket set. If a player bought (revealed) all of the tickets for a
20 game he would get all of the allocated and predetermined winners (as well as losers).

The Examiner has taken the position that "it is advantageous for to allow for a new deal after all of the winning chances have been redeemed. ... the player will feel more in control of machine, as they will be allowed to restore all of the winning

possibilities at any time. ... Therefore, it would have been obvious to one of ordinary skill in the art to incorporate this feature in to the device of Fuchs in order to allow the player to call for a reconstitution. ... it would have been obvious to one of ordinary skill in the art that the cards disclosed in Fuchs would represent the chances disclosed in

5 Richardson.” The Examiner has put forth no evidence to support her conclusions.

Richardson is concerned with a lottery-type of game and thus, it is submitted, there must be evidence to support any conclusion that one skilled in the art would look to a lottery game, where a player can select a new game (“deal” which means a new inventory set of tickets), to combine with a symbol selection game such as Fuchs, to

10 arrive at a game where the player can command reconstitution of a depleted inventory of card data. Applicant respectfully submits that Richardson does not teach reconstitution of depleted inventory as discussed above. Further, there is no showing of a any motivation in the art to combine the teachings of a lottery - style game with a random symbol selection game.

15 Reversal of the rejection of the claims of Group 2 claims is requested.

Conclusion

It is respectfully submitted that the Examiner has used hindsight to interpret and reconfigure the teachings of the cited art to cover the claims of the present invention.

None of the art discloses the features of depletion of card data, depletion to such an

20 extent that winning outcomes can be eliminated and the display of information as to which outcomes have been eliminated by virtue of depletion. Applicant further

submits that the Examiner has used hindsight to interpret, select and apply the teachings of the cited references and that the hindsight has also lead to mis-

interpretations of the teachings of the art. Finally Applicant submits that the Examiner has not produced any evidence or teachings to support the conclusions regarding motivation and combining the art in manner set forth in the Final Office Action.

Applicant respectfully requests that the rejections as to all claims be reversed.

Respectfully submitted,

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Dated: March 15, 2004

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APPENDIX

(Pending Claims Subject to This Appeal)

- 5 2. The method of claim 37 comprising displaying the constituency of the deck data available for selection and display at the completion of each hand of play.
3. The method of claim 37 comprising displaying the constituency of the deck data available for selection and display after the selection and display of card data.
4. The method of claim 37 comprising counting the number of card data selected
10 and displayed during the play of a series of outcomes and at a predetermined count X and before the play of the next hand reconstituting the card data available for selection and display to N card data.
5. The method of claim 4 comprising the player prompting reconstitution of said deck data.
- 15 6. The method of claim 37 comprising displaying the deck constituency data in a table.
7. The method of claim 6 further comprising displaying the deck constituency data in a table including the values and suits corresponding to said card data.
8. The method of claim 37 comprising counting the number of card data selected
20 and displayed during the play of the series of hands and reconstituting the deck data available for selection and display to N card data before the play of the next hand in response to the first of (1) the display of a predetermined count X of card data or (2) the display of data representing a trigger.
9. The method of claim 37 comprising counting the number of card data selected

and displayed during the play of a series of and reconstituting the deck data available for selection and display to N card data before the play of the next hand in response to the first of (1) the display of a predetermined count X of card data, (2) the display of data representing said trigger or (3) the player prompting reconstitution of said deck data

10. The method of claim 37 further comprising configuring said processor to display a pay table corresponding to each winning outcome and the corresponding award and to reconfigure the displayed pay table where deck depletion eliminates a winning outcome.

11. An electronic device for playing a hands of a card game according to the rules thereof utilizing data representing a deck of N playing cards:

a first data structure storing data representing each playing card of said deck;

a processor, said processor configured to include means for randomly arranging said playing card data into a random, serial order;

a video display;

means for a player to make a wager and prompt play of the game;

said processor, in response to prompting, configured to select and display at said display data from said first data structure representing a predetermined number of cards selected in order from said arranged data inventory to define an initial holding;

a control device for completing said initial holding according to the rules thereof by at least one of (1) replacing at least one card of the initial holding or (2) selecting additional cards, said processor configured to select and display at said display from said first data structure data representing each replacement or additional cards

selected in order from said arranged data to define a final outcome for the hand of play;

said processor configured to display at said display data corresponding to the remaining constituency of said deck data depleted of said displayed card data;

said processor further configured to display data that said depletion has

5 eliminated a final outcome; and

said processor configured to determine if said final outcome is a winning or losing outcome and to issue an award for a winning combination.

12. The device of claim 11 comprising said processor configured to display said data corresponding to said remaining constituency the deck data at the completion of each
10 hand of play.

13. The device of claim 11 comprising displaying the constituency of the deck data after the selection and display of card data.

14. The device of claim 11 comprising a counter to count the number of card data selected and displayed during the play of a series of outcomes, said processor
15 configured to, at a predetermined count X of cards and before the play of the next hand, reconstitute and reconfigure the deck data into a new, random, serial order of N card data.

15. The device of claim 11 comprising an input device to prompt reconstitution and reconfiguration of said deck data.

20 16. The device of claim 11 further comprising said processor configured to control the display to display the deck constituency data in a table.

17. A method for playing an electronic Video Poker game utilizing data representing a deck of N playing cards comprising:

providing a data processor including a first data structure storing data
representing at least one deck of N playing cards according to the rules of the game:

configuring the playing card data into a random, serial order;

a player making wagers and playing a series of hands;

5 for each hand of play, selecting data from the first data structure and displaying
at an electronic display data representing an initial holding of playing cards defining an
initial holding, said data selected in order from the serially arranged deck data;

selecting a card of the initial holding to replace, said processor for any selected
card to replace selecting and displaying one or more cards selected in order for the

10 serially arranged deck data to define a final outcome, card combination;

displaying the constituency of the deck data depleted of said displayed cards;

comparing said final outcome card combination to data stored in a second data
structure representing winning outcome combinations and if a winning outcome
combination has been obtained issuing an award ; and

15 if said depletion of said deck has eliminated the availability of any winning
outcome, displaying information of said elimination .

18. The method of claim 17 comprising displaying the constituency of the deck data
at the completion of each hand of play.

19. The method of claim 17 comprising displaying the constituency of the deck data
20 after the selection and display of card data.

20. The method of claim 17 comprising counting the number of card data selected
and displayed during the play of a series of outcomes and at a predetermined count X
and before the play of the next hand reconstituting and reconfiguring the deck data into

a new, random, serial order of N card data.

21. The method of claim 20 comprising the player prompting reconstitution and reconfiguration of said deck data.

22. The method of claim 17 further comprising displaying the deck constituency data
5 in a table.

23. The method of claim 22 further comprising displaying the deck constituency data in a table including the values and suits corresponding to said card data.

24. The method of claim 17 comprising counting the number of card data selected and displayed during the play of a series of outcomes and reconstituting and
10 reconfiguring the deck data into a new, random, serial order of N card data before the play of the next hand in response to the first of (1) the display of a predetermined count X of card data or (2) the display of data representing a trigger.

25. The method of claim 17 comprising counting the number of card data selected and displayed during the play of a series of outcomes and reconstituting and
15 reconfiguring the deck data into a new, random, serial order of N card data before the play of the next hand in response to the first of (1) the display of a predetermined count X of card data, (2) the display of data representing said trigger or (3) the player prompting reconstitution and reconfiguration.

26. The method of claim 17 further comprising configuring said processor to display
20 a pay table corresponding to each winning outcome and the corresponding award and to reconfigure the displayed pay table where deck depletion eliminates a winning outcome.

27. An electronic device for playing a hands of a Video Poker game utilizing data

representing a deck of N playing cards:

a first data structure storing data representing each playing card of said deck;

a processor, said processor configured to include means for randomly arranging said playing card data into a random, serial order;

5 a video display;

means for a player to make a wager and prompt play of the game;

said processor, in response to prompting, configured to select and display at said display data from said first data structure representing a predetermined number of cards selected in order from said arranged data inventory to define an initial holding;

10 a control device for the player to select from said initial holding at least one card to discard, said processor configured to select and display at said display from said first data structure data representing the cards selected in order from said arranged data a card to replace each discarded card and to define a final outcome for the hand of play; said processor configured to display at said display data corresponding to the remaining

15 constituency of said deck data depleted of said displayed card data;

said processor configured to compare said outcome to a schedule of winning outcomes stored in a second data structure and to issue an award for a winning combination; and

said processor further configured to display data that said depletion has
20 eliminated a final outcome.

28. The device of claim 27 comprising said processor configured to display said data corresponding to said remaining constituency the deck data at the completion of each hand of play.

29. The device of claim 27 comprising displaying the constituency of the deck data after the selection and display of card data.

30. The device of claim 27 comprising a counter to count the number of card data selected and displayed during the play of a series of outcomes, said processor

5 configured to, at a predetermined count X of cards and before the play of the next hand, reconstitute and reconfigure the deck data into a new, random, serial order of N card data.

31. The device of claim 30 comprising an input device to prompt reconstitution and reconfiguration of said deck data.

10 32. The device of claim 27 further comprising said processor configured to control the display to display the deck constituency data in a table.

33. The device of claim 32 further comprising said processor configured to control the display to display the deck constituency data in a table including the values and suits corresponding to said card data.

15 34. The device of claim 27 wherein said card data includes data representing a Joker and comprising a counter to count the number of card data selected and displayed during the play of a series of outcomes and said processor configured to reconstitute and reconfigure the deck data into a new, random, serial order of N card data before the play of the next hand in response to the first of the (1) display of a
20 predetermined count X of card data or (2) the display of data representing said Joker.

35. The device of claim 27 comprising a counter to count the number of card data selected and displayed during the play of a series of outcomes, an input device and said processor configured to reconstitute and reconfigure the deck data into a new,

random, serial order of N card data before the play of the next hand in response to the first of (1) the display of a predetermined count X of card data, (2) the display of data representing selected card data or (3) the input of a signal with said input device to prompt reconstitution and reconfiguration.

5 36. The device of claim 27 comprising said processor configured to display a pay table corresponding to each winning outcome and the corresponding award and to reconfigure the displayed pay table where deck depletion eliminates a winning outcome.

37. A method for playing a card game according to the rules thereof comprising:

- 10 (a) providing a data processor having a first data structure storing data representing each playing card of at least one deck of N playing cards used according to the rules of the game;
- (b) a player making a wager to play a hand of the game and prompting play;
- (c) according to the rules of the game, displaying cards randomly selected by
- 15 the processor from the data structure to define an outcome for the hand;
- (d) assessing the outcome for the hand to determine if the outcome is a winning outcome according to the predetermined rules of the game and if the outcome is a winning outcome issuing an award to the player;
- (e) depleting the card data available for selection and display for subsequent
- 20 selection and display of card data which has been previously selected and displayed;
- (f) displaying information to the player of any winning outcomes eliminated by said depletion; and
- (g) to play subsequent hands repeating steps (b) - (f)..

38. The method of claim 37 comprising at a predetermined depletion of said card data, reconstituting the deck data available to said data representing N cards.

39. The method of claim 38 comprising the player prior to making a wager prompting the processor to reconstitute the deck data available to data representing N cards.

5 40. The method of claim 37 comprising said game is Poker, displaying a winning outcome award schedule for predetermined winning Poker hand outcomes and where depletion of said data has eliminated the availability of an award from said schedule, indicating said elimination.

41. The method of claim 37 comprising configuring said card data into a random
10 serial order of cards N and selecting and displaying said cards from said data structure for said hands serially from said deck data.

42. A method for playing a card game according to the rules thereof comprising:

(a) providing a data processor including a first data structure storing data representing at least one deck of N playing cards according to the rules of the game,
15 said card data including data for said cards corresponding to value, the suit of Clubs, Diamonds, Hearts and Spades and where a Joker is included in N, data representing said Joker; :

(b) a player making a wager to play each of a series of hands of play;

(c) for each hand of play, randomly selecting and displaying from said first
20 data structure at an electronic display data representing an initial holding of at least two playing cards and completing the initial holding to a final holding according to the rules thereof by at least one of (1) displaying additional cards or (2) replacing selected cards, said processor for any additional or replaced card randomly selecting and displaying

card data from said data structure to define said final outcome, card combination;

(d) displaying a tally corresponding to the constituency of the deck data of said data structure depleted of said cards displayed in the play of the preceding hands, said tally displaying the values and suits of said remaining constituent data including the display of any card values or suits which have been completely depleted;

(e) for each hand determining if the players final outcome is a winning or a losing outcome and issuing an award corresponding to a winning outcome; and

(f) at one of (i) the selection and display of a predetermined trigger card or (ii) a predetermined depletion of said deck data, re-constituting the deck data representing N cards.

43. The method of claim 42 comprising displaying any outcomes rendered unavailable by depletion of said deck data.

44. A method for playing a card game according to the rules thereof and using an inventory of playing cards including the four suits of Clubs, Diamonds, Hearts and

Spades the method comprising:

storing data representing each playing card;

the player making wagers to play a series of hands of the game, each hand of the series played by a processor selecting and displaying (1) an initial set of cards and (2) additional or replacement set of cards from said inventory to produce a final,

concluding, outcome for the hand,

excluding from selection and display data for cards which have been selected and displayed;

displaying data corresponding to a game outcome eliminated by said exclusion;

and

issuing an award to the player for any hand of the series having a predetermined winning final outcome.

45. The method of claim 44 comprising displaying to the player data corresponding to the values and suits of all cards remaining available for selection and display.

46. The method of claim 44 comprising reconstituting to a full compliment of card data upon the exclusion of card data representing a predetermined number of cards and before the play of the next hand..

47. A electronic device for playing a card game according to the rules thereof and using an inventory of playing cards including the four suits of Clubs, Diamonds, Hearts and Spades the device comprising:

a data structure storing data representing each playing card;

a video display;

means for a player to input wagers to play a series of hands of the game;

a processor configured to select and display at said display (1) an initial set of cards and (2) additional or replacement set of cards from said inventory to produce a final, concluding, outcome for the hand,

said processor configured to exclude from selection and display data for cards which have previously been selected and displayed and to displaying data

corresponding to a game outcome eliminated by said exclusion; and

Said processor configured to determine if said outcome for the hand is a winning final outcome and if so to issue an award to the player..

48. The device o claim 47 comprising said processor configured to control the

display to display the inventory of cards which have not been excluded..